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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
Jay Paul Drummond, et al.	)	
	)	
Serial No.: **09/193,646**	)	Art Unit 3621
	)	
Confirm. No.: **2283**	)	
	)	Patent Examiner
Filed: **November 17, 1998**	)	Calvin Loyd Hewitt II
	)	
Title: **Automated Banking Machine**	)	
Apparatus and System	)	

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF OF APPELLANTS

PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in

triplicate, concerning the above-referenced Application.

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REMARKS

The Examiner's Answer ("Answer") dated October 22, 2002 is acknowledged.

The Issues for Review in the Answer

The Answer beginning at page 3, line 1 through page 6, line 4 is substantially similar to pages 2-5 of the Action (dated May 15, 2002) from which the appeal was taken. Appellants have already addressed the issues of record (i.e., the rejections) in their Appeal Brief.

Reply to additional comments in the Answer

The Answer includes a "Response to Argument" section (beginning on page 6) which includes additional comments. Appellants respectfully submit that many of the issues mentioned in this section have already been addressed in the Appeal Brief. Furthermore, the Answer misinterprets the references and misstates Appellants' arguments. Thus, please note the Appeal Brief.

The Zeanah Provisional Application

The Answer alleges that Zeanah's provisional application is enabling. Thus, the Answer further alleges that the Zeanah patent is entitled to the October 31, 1996 filing date of the provisional. The Appellants respectfully disagree. The Appeal Brief provides detailed reasons as to why Zeanah's provisional application does not meet the requirements of the first paragraph of 35 U.S.C. § 112 (e.g., written description and enablement requirements). The Zeanah provisional specifically states that it is not an enabling disclosure.

As discussed in the Appeal Brief, the Zeanah provisional application comprises a combination of three separate documents: first document (pages 1-9); second document (pages i to A-5); and third document (section numbered pages 1-47).

The first document (pages 1-9) is a requirements section of what the inventors would like to do, but lacks any presentation of knowledge of how to do it. The first document does not meet the requirements of 35 U.S.C. § 112, first paragraph. Even the Answer (at page 6, line 15) admits that one would have to read the provisional application "beyond the requirements section."

The second document of the Zeanah provisional application (pages i to A-5) also does not meet the requirements of 35 U.S.C. § 112, first paragraph. The second document itself admits (page 1-1) that "The primary focus of this document is the conceptual application architecture" and that "following the adaption of this conceptual architecture, the next level of design work will take place fleshing out the details." That is, the provisional application admits that after the alleged concept was completed (which it was not), then the next work (which hadn't even started yet) would involve figuring out the details (the guts of any inventive subject matter) necessary in order to implement the asserted concept.

The third document of the Zeanah provisional application (section numbered pages 1-47) also does not meet the requirements of 35 U.S.C. § 112, first paragraph. The third document (at page 2) lists the five process steps needed to reduce to practice the asserted conceptual idea. However, a close reading of the provisional application reveals that only step one (basic theoretical idea) was ever begun. The third document at page 47 (last page of the provisional

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application) is evidence that steps two through four were yet to begin. Page 47 admits that the necessary "next steps" of obtaining an architecture, selecting the proper tools, defining an implementation strategy, staffing a design team, and starting the detailed design were not yet completed (or begun). That is, steps two through four were not completed (or even begun) as of the filing date of October 31, 1996. It should also be noted that step four (page 2 of the third document) admits that the "how", which is an integral component of enablement, is lacking.

Zeanah's provisional application itself provides evidence that it does not meet the requirements of the first paragraph of 35 U.S.C. § 112 (e.g., written description and enablement requirements). The Examiner cannot substitute his own judgement as to enablement for that of the provisional application inventor (Zeanah).

Therefore, the Zeanah patent is not entitled to the October 31, 1996 filing date of the non enabling provisional application. The Zeanah patent is, at best, only entitled to the August 7, 1997 filing date. However, the application that is the subject of the appeal claims the benefit of the November 27, 1996 filing date of provisional application 60/031,956. Thus, the Zeanah reference cannot constitute prior art against Appellants' invention.

The Answer also alleges (regarding Zeanah's provisional application) that "one of ordinary skill would find ample support for features described in the '816 Patent." The Appellants respectfully disagree. Appellants respectfully submit that the Answer also fails to correctly ascertain the level of one having ordinary skill in the art at the time of the October 31, 1996 filing date of Zeanah's provisional application. Appellants respectfully submit that the Office did not reach a conclusion based on facts gleaned only from the prior art. That is, the

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Office incorrectly applied the level of one having ordinary skill in the art of today. The Office's attempted usage of hindsight to breathe enablement into the Zeanah provisional application is legally impermissible. Thus, it is respectfully submitted that Zeanah's provisional application is further lacking the requirements of the first paragraph of 35 U.S.C. § 112 due to the wrongful application of the level of one having ordinary skill in the art.

Appellants also contend that Zeanah does not constitute prior art due to Appellants' entitlement to conception and reasonable diligence. The present invention claims benefit of the November 27, 1996 filing date of Provisional Application 60/031,956. The difference between Zeanah's October 31, 1996 provisional application filing date and Appellants' November 27, 1996 provisional application filing date is approximately twenty-seven (27) days. Appellants' provisional application includes 37 pages of Specification; 30 claims; an Abstract; and 24 sheets of drawings. Appellants respectfully submit that the twenty-seven (27) days falls within a time period of reasonable "attorney-diligence" and "engineering-diligence," which does not require an inventor or his/her attorney to drop all other work and concentrate on the particular invention. *Bey v. Kollonitsch*, 866 F.2d 124, 231 USPQ 967, 970 (Fed. Cir. 1986); *Emery v. Ronden*, 188 USPQ 264, 269 (Bd. Pat. Inter. 1974); and *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 214, 216 (CCPA 1959). Thus, Appellants respectfully submit that (if necessary) they are clearly entitled to be credited with conception and reasonable diligence from a date prior to the filing date of Zeanah's provisional application to the November 27, 1996 filing date of their provisional application. Thus, the Zeanah patent further does not constitute prior art against Appellants' invention.

<u>Claims 1-22 and 33</u>

Again, many of the issues mentioned in this section have already been addressed in the Appeal Brief.

The Answer (on page 10) apparently attempts to define Appellants' "transaction data object" as anything which may include transaction data reflecting a deposit, withdrawal, or inquiry by referring to Appellants' Specification at page 74, lines 9-16. The Answer (at page 10, lines 7-9) further alleges that to one of ordinary skill in the art the recited "transaction data object" "is merely an ATM receipt." The Answer also alleges that Zeanah teaches a receipt by "queuing transaction data in order to provide users with a printed record ('816, column 13, lines 55-58)." The Appellants respectfully disagree.

The Appellants respectfully submit that the Answer takes out of context the Appellants' Specification at page 74, lines 9-16. The Specification at page 74, lines 1-16 actually reads:

Figure 31 is a schematic representation of the operation of the system in printing forms using a printer in an automated transaction machine. The preferred form of the invention uses the WIN32 printer services which operate under Windows NT® 4.0. In the exemplary transaction shown, the director manager class 180 operating in the terminal theater portion 138 initiates a print receipt transaction by requesting a printer director 182 to print a receipt. The printer director in one preferred embodiment is a collection of instances of related JAVA beans which operate to carry out printing activities, and is one of the directors among the terminal directors 144. The printer director includes a print class which is schematically shown separately which is operative to invoke a print URL

method. The printer class in the preferred embodiment includes access to the shared transaction data object which includes the customer specific information concerning the transaction that includes indicia representative of information to be printed. In the case of an automated banking machine this may include for example indicia representative information which is read from a customer's card input to the machine and read by a card reader. This would include for example the customer's name and account number. The other transaction information may include the types of transactions conducted such as a deposit, withdrawal or inquiry as well as the amount involved in each respective transaction.

Further discussion regarding Appellants' "transaction data object" may be found at Specification page 26, lines 1-12, and page 64, lines 10-13:

> This record in a preferred embodiment may be stored in memory as data in an object in software. The object is preferably used to accumulate data as the transaction proceeds. The data stored in the transaction data object preferably includes data input through input devices by the user as well as data representative of operations carried out by transaction function devices.
>
> The record or transaction data object provides persistence through what may be several different transaction steps executed by the customer. The ability to use and share the data in a number of different operations avoids the need to derive it or obtain it from a customer more than once in the course of a user session involving a number of transaction steps. The use of a transaction data object enables applets to run largely independently, obtaining needed data from the transaction object. The approach also

enables the record or data object to be used to produce an appropriate record at the end

of the transaction session. This record may be stored, collected into a batch or delivered

to selected addresses in a local or wide area network.

As previously discussed, the transaction data object holds transaction data. The machine

acquires data pertinent to the transaction such as account data from a card, a customer's

PIN number, requested transaction(s) and amount(s), and includes this data among the

transaction data.

As can be seen, the recited "transaction data object" cannot be an "ATM receipt" as

alleged. Even the Answer's relied upon section (page 74, lines 9-16) of Appellants' Specification

states that "a printer director 182 to print a receipt . . . The printer director includes a print class .

. . The printer class . . . includes access to the shared transaction data object which includes . . .

information to be printed." Thus, if the transaction data object (in the cited section) includes

information to be printed on a receipt, then how can the transaction data object constitute the

receipt?

Additionally, the Answer misstates Zeanah at col. 13, lines 55-58. The cited section

actually states:

> The mini-app dialog component 83 queues transaction data for printed record and
>
> increments transaction counters in the instrumentation component 76.

The cited section does not refer to providing "users" with a printed record, as alleged.

Nor does Zeanah teach or suggest a "receipt" or an "ATM receipt."

Furthermore, Zeanah's remote devices are remote from the delivery system (12) (e.g.,

Figure 1). The delivery system includes the components 83 and 76 (Figure 2) which are mentioned in the relied upon section of Zeanah (at col. 13, lines 55-58). It is unclear how a printed record (the alleged ATM receipt) can be transferred from Zeanah's delivery system (12) to a remote device. Rather, the referenced "printed record" appears to be for internal record keeping in Zeanah. (As previously discussed, Appellants have been required to speculate as to how the Zeanah system could be made to operate because the disclosure of Zeanah (both the patent and the provisional application) is incomprehensible due to lack of details thereof).

Also, Appellants' claims (e.g., claim 1) are clear that "software" includes the "transaction data object." It is unclear how software can include a printed record, i.e., ATM receipt (the alleged transaction data object). Thus, an "ATM receipt" cannot constitute the recited "transaction data object", as alleged.

The Answer (on page 10) further alleges that transaction data must be stored in order to provide a printed record of a transaction. It is unclear whether the Answer is alleging that just because an ATM prints a receipt then it must have a transaction data object (in software). Nevertheless, ATMs have been around since approximately the late 1960s. At least some of these ATMs could print a receipt for a user. However, this does not mean that they had a transaction data object or a transaction data object in software. Rather, they stored data in memory and had separate programs to recover the data from the memory. No transaction data object was involved. It is not clear whether Zeanah operates the same way as these old ATMs. However, there is no evidence that a transaction data object is inherent in Zeanah. That is, there is no evidence that a transaction data object is "necessarily present" in Zeanah.

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Inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in the cited reference. Inherency may not be established based on probabilities or possibilities. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). Furthermore, an assessment of basic knowledge and common sense by the Office that is not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Likewise, Zeanah does not inherently teach an applet (claim 10) or a back office processing system (claim 9) in the manner recited, as alleged on page 11 of the Answer. For example, there is no evidence that a back office processing system is "necessarily present" in Zeanah.

The Answer at page 8, lines 16-19, alleges that Appellants' software objects (e.g., first and second objects of claim 1) are in line with the teachings of Zeanah. Appellants respectfully disagree with the interpretation and application of the Zeanah reference. Regardless, the Answer does not allege that Zeanah teaches or suggests Appellants' transaction data object as a software object. Rather, the Answer alleges that Zeanah teaches Appellants' transaction data object as a printed ATM receipt (Answer at page 10, lines 7-19).

It follows that Zeanah does not disclose or suggest the specifically recites features, relationships, and/or steps. Nor would it have been obvious to have modified Zeanah to have produced the recited invention. The Answer is devoid of any such teaching, suggestion, or

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motivation for combining features of the Zeanah reference to have produced the recited

invention. The Office has not established a *prima facie* showing of obviousness.

Claims 23-32

Again, many of the issues mentioned in this section (Answer pages 12-13) have already

been addressed in the Appeal Brief.

The Answer (at page 12) misinterprets Appellants' comment that Wynn's card does not

communicate with an automated transaction machine. The comment is with regard to claim 24.

Claim 24 depends from claim 11 and further recites transferring data object data between a hand

held device and the machine. Thus, Wynn's card does not communicate with an automated

transaction machine (in the manner recited in claim 24).

The Answer (at page 12) again alleges that receipts are transaction data objects. The

Answer also states that Wynn teaches printing ATM receipts. As previously discussed, an ATM

receipt cannot constitute the recited "transaction data object." For example, the claims (e.g.,

claim 23) are clear that the transaction data object is in "software." It is unclear how software

can include an ATM receipt. Appellants' remarks regarding claims 1-22 and 33 are herein

incorporated by reference.

The Answer also relies on certain documents, e.g., Microsoft Press Computer Dictionary

(Third Edition) and Webster's Ninth New Collegiate Dictionary. No evidence has been presented

that these documents constitute prior art against Appellants' invention. Thus, Appellants assert

that these documents must be disregarded.

Additional Comments

The Examiner's offer to "expound on the ideas expressed in the aforementioned Office Action in hopes of further clarifying the Examiner's position" (Answer page 7) is merely an attempt to expand the rejections (e.g., a transaction data object is an ATM receipt). Nevertheless, as shown herein, an ATM receipt cannot constitute a transaction data object, as alleged. Appellants respectfully submit that the Answer's unfounded allegation is a further example of the Office's unfair interpretation of the issues and is reflective of all the rejections on appeal. Neither Zeanah nor Wynn, taken alone or in combination, discloses or suggests the recited features and relationships. The Office has not established a *prima facie* showing of obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,
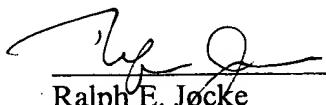
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